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Customer No. 58,982
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Steven R. JANDA	Group Art Unit: 3629
Application No.: 10/026,965	Examiner: Dennis W. Ruhl
Filed: December 27, 2001	Confirmation No.: 1798
For: AUTONOMOUS RENTAL STORE	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

Pursuant to 37 CFR § 41.41(a)(1), Appellant presents this Reply Brief in response to the Examiner's Answer mailed on November 16, 2006.

I. Status of Claims

In response to the Appeal Brief filed on October 4, 2006, the Examiner has maintained the rejection of claims 16-18, 20, 21, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by Brown et al., U.S. Patent Application Publication No. 2002/0118111 A1 ("*Brown*"); and claims 1, 2, 5-15, 19, 22, 31, and 32 under 35 U.S.C. § 103(a) as being unpatentable over *Brown*.

II. Response to Examiner's Arguments in the Answer

In addition to the arguments for reversal of the outstanding final rejection provided in Appellants' Appeal Brief filed on October 4, 2006, Appellant provides the following remarks regarding the Examiner's Answer ("Answer") mailed on November 16, 2006.

Regarding the rejection of claims 16-18, 20, 21, 29, and 30 under 35 U.S.C. § 102(e), the Examiner states,

> "Applicant has recited two secure areas and this language is broad enough to read on any two areas of room 110, such as a first area that is located in the area where a customer enters room 110, and a 2nd secure area such as the area where the item(s) is located that is being removed" (Answer at page 9).

Even assuming that areas where items are removed could constitute the claimed "second secure areas," which Appellant strongly disputes, *Brown* does not teach or suggest "second secure areas" that are "assigned to a customer," as recited in claim 16. In *Brown*, once the user is inside storage room 110, the user has access to all areas of the room. Because all users have access to all parts of storage room 110, no second secure areas that are "assigned to a customer" exist. Therefore, *Brown* does not teach "a

plurality of second secure areas accessible from the first secure area, one of which is assigned to a customer," as recited in claim 16.

Moreover, *Brown* does not disclose billing the customer for missing equipment. The Examiner cites paragraph 17 and states that it "discloses that the information concerning the items that are removed and returned 'can be used to . . . bill an appropriate party for goods'" (Answer at page 11). The Examiner has mischaracterized *Brown*.

Brown "bills an appropriate party for goods" (Paragraph 0017). *Brown* does not teach or suggest associating missing equipment with an invoice. On the contrary, billing occurs when the user removes the items (Paragraph 0033 and Fig. 3). *Brown* discloses an auto-return (Fig. 3, step 340), but this auto-return is not associated with billing the user. As shown in Fig. 3, billing occurs when the user removes the items, and the auto-return is separate from billing. Therefore, *Brown* does not teach "an invoice component that bills the customer for a cost associated with the missing rental equipment item," as further recited in claim 16.

Brown fails to teach at least these elements, and *Brown* cannot anticipate claim 16 and dependent claims 17, 18, 20, and 21. Independent claim 29, while of a different scope, recites limitations similar to those of claim 16 and is thus allowable over *Brown* for at least the same reasons discussed above with regard to claim 16. Dependent claim 30 is also allowable at least because it depends from claim 29.

Regarding the rejection of claims 1, 2, 5, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over *Brown*, the Examiner states "[t]o claim that an area is assigned

to a customer really means nothing in the opinion of the Examiner" (Answer at page 12). Appellant respectfully disagrees with the Examiner's statement.

The claim language referred to by the Examiner (i.e. "assigned to the customer") serves to further define the second secure area. In order to practice the claimed invention, the step of "selectively providing the customer access to the second secure area" is met only when the customer is permitted to access a secured area assigned to herself. Thus, this limitation must be given weight by the Examiner. *Brown* does not disclose nor suggest a second secure area that is assigned to a particular customer, nor does *Brown* disclose or suggest selectively providing access to such an area.

As previously stated, all items within the room are accessible, and no items within the room are within a second secure area. Because the user has access to all parts of storage room 110, no second secure areas exist. There is one secure entrance to storage room 110, and once the user is inside the room, the user may access all parts of the room. There is no part of the room to which access may be selectively granted to the user. Therefore, *Brown* does not teach the step of "selectively providing the customer access to the second secure area assigned to the customer based upon the sensed identity of the customer," as recited in claim 1.

The Examiner's continued reliance on the alleged method of renting and returning videos at a video rental store does not cure the deficiencies of *Brown*. There is no "second secure area" in *Brown*, therefore *Brown* does not teach or suggest the step of "automatically generating a return list of rental equipment items returned to the second secure area by the customer." A video rental store also fails to disclose this claimed feature. Moreover, *Brown* associates inventory with a user, but does not determine "at

least one missing rental equipment item listed on the rental list and not listed on the return list." Therefore, *Brown* does not teach or suggest "storing a designation of the at least one missing rental equipment item together with an identifier of the customer," as further recited in claim 1.

Accordingly, *Brown* fails to establish a *prima facie* case of obviousness with respect to claim 1, at least because the reference fails to teach or suggest each and every element of the claim. Dependent claims 2, 5, 6, and 7 are also allowable at least because these claims depend from claim 1.

Regarding the rejection of claims 8-15, the Examiner states that "Applicant's argument seems to be based on the premise that Brown discloses that employees take in returned items and then scan them or enter their information into a computer manually" (Answer at page 14). The Examiner has taken Appellant's statements out of context.

The Examiner has combined the teachings of *Brown* with the actions of employees at a video rental store (Answer at page 6). Appellant's statements in the Appeal Brief addressed both the method in *Brown* and in video rental stores. Appellant's arguments addressing employees were directed to those at a video store (Appeal Brief at page 18).

Brown does not teach or suggest "automatically generating a return list of each piece of equipment sensed being moved into the secure area" and "determining at least one missing rental equipment item listed on the rental list but not listed on the return list." A return list is not generated.

Appellant continues to assert that even if a video rental store could generate a return list, absent any teaching in prior art, an employee must enter the video information. This manual act cannot constitute the step of "automatically generating a return list of

each piece of equipment sensed being moved into the secure area," as recited in claim 8. Therefore, the prior art does not teach "determining at least one missing rental equipment listed on the rental list but not listed on the return list," as further recited in claim 8.

Accordingly, *Brown* fails to establish a *prima facie* case of obviousness with respect to claim 8. Dependent claims 9-12 are also allowable at least because these claims depend from claim 8.

Independent claim 13, while of a different scope, recites limitations similar to those of claim 8 and is thus allowable over *Brown* for at least the same reasons discussed above with regard to claim 8. Dependent claims 14 and 15 are also allowable at least because these claims depend from claim 13.

Regarding the rejection of claims 31 and 32, *Brown* only bills the user for items removed from the storage room 110. Therefore, *Brown* does not teach "determining a missing rental equipment item previously removed from the secure area by the customer but not among the plurality of pieces of equipment moved within the predetermined distance from the entrance of the secure area" and "automatically billing the customer for use of the missing rental equipment item," as recited in claim 31.

The Examiner states that one of ordinary skill "would have been motivated to bill the customer for items that are not returned so that the rental business owner would not be losing inventory without proper compensation" (Answer at page 8). Nothing in *Brown* suggests this motivation. Even assuming that billing customers for items that are not returned is well known in the art of video store rentals, this billing occurs when an employee of the video manually enters the information for the videos that are returned and determines that other videos are due and have not been returned. If videos are

overdue, the employee may call the user and inform her that a video is overdue (as discussed in the Official Notice taken by the Examiner on pages 6-7 of the Answer) and that a late fee may be associated with the video.

However, nothing in *Brown* or common video stores suggests the step of "automatically billing the customer for use of the missing rental equipment item." *Brown* does not teach or suggest billing for missing rental equipment. On the contrary, billing occurs when the user removes the items (Paragraph 0033 and Fig. 3). *Brown* discloses an auto-return (Fig. 3, step 340), but this auto-return is not associated with billing the user. As shown in Fig. 3, billing occurs when the user removes the items, and the auto-return is separate from billing.

At a video store, a bill is not generated until the person returns the overdue video. Once the video is returned, a late fee is charged associated with the number of days that the video is overdue. The customer is billed based on how long she kept the video past the due date. The bill associated with the late fee is generated, and the customer is billed, when the overdue video is returned. Alternatively, if the customer never returns the video, the customer will be billed after appropriate steps have been taken to remind the customer to return the video and to warn the customer that she will be charged if the video is not returned. Therefore, this method of billing a customer does not include the step of "automatically billing the customer for use of the missing rental equipment item" once it has been determined that an item is missing.

Accordingly, *Brown* fails to establish a *prima facie* case of obviousness with respect to claim 31. Dependent claim 32 is also allowable at least because it depends from claim 31.

III. Conclusion

For the reasons given above, and those reasons provided in Appellant's Appeal Brief, Appellant respectfully submits that the rejections of claims 1, 2, 5-22, and 29-32 are in error and should be reversed.

If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 12, 2007

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